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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,341	01/05/2001	Junji Miyata	Q62470	3667

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
WASHINGTON, DC 20037

EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/754,341

Applicant(s)
Miyata et al.

Examiner
Clark F. Dexter

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3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Sep 19, 2002.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-8 is/are pending in the application.

4a) Of the above, claim(s) 3-8 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1 and 2 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2

6) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I (claims 1 and 2), Species A (Figures 1-3 readable on claims 1-3) in the response filed September 19, 2002 (paper no. 5) is acknowledged. The traversal is on the ground(s) that applicant's position appears to be that applicant is prohibited from claiming "the combination which is the entire invention" and that "Applicants are effectively prevented from fully claiming even the species in a single application."

However, Applicant has disclosed at least six species and appears to have claimed more than two of them. In addition, in defining one of the species, applicant has set out in two distinct directions to patentably distinguish the claimed invention over the prior art; specifically, applicant has directed one group of claims (Group I, claims 1-2) toward the specific structure of the co-use ascending/descending guide means, and has directed another group of claims (Group II, claims 3-8) toward the specific type of drive means. The structure of each of these groups must be separately and independently considered with regards to patentability and thus these groups are considered to be directed to different inventions (i.e., subcombinations). The examination of multiple inventions (i.e., subcombinations) in the time allotted for a single invention creates an undue burden on the Examiner, particularly since multiple inventions results in multiple fields of search and multiple scopes of invention leading to multiple patentability considerations. However, to relieve Applicants' burden, Applicants may state that the groups are

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not patentably distinct and all of the claims in both groups that are directed to the elected species will be examined. It is noted, however, that such a statement may be used as an admission of obviousness and may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on May 17, 2000. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

3. The information disclosure statement filed January 5, 2001 (paper no. 2) has been received and the reference listed thereon has been considered.

Drawings

4. The drawings are objected to because in Figure 12, [✓]“C” appears to be misplaced and inaccurate, and it seems that it should be deleted. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Specification

5. The disclosure is objected to because of the following informalities:

In paragraph 0014, ✓ the entire paragraph is awkwardly worded and unclear as to what is being described.

In paragraph 0031, ✓ lines 2-3 contain redundant language and are unclear.

In paragraph 0049, "the second" appears to be inaccurate, and it seems that it should read ✓ ~~the second~~ *a*
--a third--.

In paragraph 0055, ✓ "present" is misspelled.

In paragraph 0063, line 2, ✓ it seems that the second occurrence of "unit" should read
--means-- or the like for consistency and clarity.

In paragraph 0072, lines 7-9 are confusing and appear to be inaccurate since it appears that numeral 54 is intended to refer to the tip end member, and it seems that in line 7, ✓ "54" should be deleted and re-inserted after "member", and in line 9, "made by metal" should be *← ✓*
deleted for clarity.

In paragraph 0077, line 1, ✓ "11" refers to the prior art device and appears to be inaccurate, and it seems that it should read --50-- or the like; in line 3, ✓ "29" appears to be inaccurate, and it seems that it should be changed to --27a-- or the like.

In paragraph 0078, line 13, ✓ "11" refers to the prior art device and appears to be inaccurate, and it seems that it should read --50-- or the like.

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In paragraph 0083, line 3, [✓]“(Figs. 1 to 7)” appears to be inaccurate, and it seems that “7” should be changed to -- 4 -- or the like.

In paragraph 0087, line 4-5, [✓]“Figs. 4 to 6” appears to be inaccurate, and it seems that it should read -- Fig. 4 -- or the like.

In paragraph 0093, line 3, [✓]“63” appears to be inaccurate, and it seems that it should be changed to --62--; also in line 3, [✓]“30a” appears to be inaccurate, and it seems that it should be changed to --28a-- or the like.

In paragraph 0112, line 2, [✓]“11” refers to the prior art device and appears to be inaccurate, and it seems that it should read --50-- or the like; in line 3, the recitation “upper blade portion or a guide member 80” is unclear as to what is being described, particularly since these two features do not appear to be equivalent structures. [✓] [✓]

In paragraph 0114, line 2, [✓]“11” refers to the prior art device and appears to be inaccurate, and it seems that it should read --50-- or the like.

In paragraph 0118, line 2, [✓]“11” refers to the prior art device and appears to be inaccurate, and it seems that it should read --50-- or the like.

In paragraph 0119, line 1, [✓]“Fig. 11” appears to be inaccurate, and it seems that it should read --Fig. 10-- or the like.

In paragraph 0121, line 4, [✓]“58” appears to be inaccurate, and it seems that it should be changed to --60-- or the like.

Appropriate correction is required.

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Claim Rejections - 35 USC § 112

6. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 9-10, “the upper blade portion ascending/descending guide means” lacks positive antecedent basis; in lines 10-11, “the lower blade portion ascending/descending guide means” lacks positive antecedent basis; in lines 11-12, “the ascending/descending guide means for holding a clearance between the upper and lower blade portions” lacks positive antecedent basis; in lines 13-14, the recitation “is used in common as a co-use ascending/descending means out of said plurality of ascending/descending guide means” is vague and indefinite as to what is being set forth, particularly since the recitation “co-use ascending/descending means” refers to a separate disclosed structure, and it is not clear as to what is means by the subject recitation, particularly the use of “is used in common as”.

Prior Art


7. Further consideration of the claimed invention with respect to the prior art will be given upon clarification of the claimed invention.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3590; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
December 2, 2002